

REMARKS

Claims 1-8, 10-13, and 16-34 are pending. Claims 1, 10, 11 and 32-34 are amended. Claims 1 and 32-34 are amended stylistically. The amendment to claims 10 and 11 provides consistency with claim 1, the basis for which may be found, for example, at paragraphs 24-26 on page 8 of the specification.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1-8, 10-13, and 16-34 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. Although Applicants submit the transitional term ‘comprising’ is synonymous with “including” (*see* MPEP 2163 II), claims 1 and 32-34 have been amended to remove the objectionable language. Such amendments are otherwise not intended to alter the scope of the claims. Withdrawal of the rejection is respectfully requested.

Rejections Under 35 U.S.C. § 102(b)

Claims 1-8, 10-13, 16-22, 24, 25, 27-31, and 34 were rejected as allegedly anticipated under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,994,493 (“the 493 patent”). The 493 patent concerns a polyurethane composition based on (i) polyether polyols and/or polyester polyols and (ii) aromatic diols. *See*, for example, the Abstract and column 4, lines 23-39. The 493 patent does not teach a composition lacking an aromatic diol component as claimed by Applicants.

The Office, however, asserts that the instant claims “do not exclude polyethers from being initiated by the aromatic polyol of the reference.” Office Action at page 9. Applicants submit that claim 1 does not merely recite polyether-polyols but claim 1 further states that the “polyether-polyols are selected from the group consisting of polytetramethylene glycols, polypropylene glycols, copolymers of ethylene oxide and propylene oxide, and alkylene diols.” None of these compounds are derived from aromatic diols. For at least this reason, the instant claims are not anticipated by the 493 patent.

The Office further asserts that the language “at least one compound” contributes to the inclusion of aromatic diol residues in the instantly contained compositions. Office Action

at pages 7 and 9. Even if there is more than one compound encompassed by the “at least one” language, each of such compounds is limited to those selected from the group consisting of polyether-polyols having number average molecular weights less than 1,000, polyalkylene diols having number average molecular weights less than 1,000, and polyester-polyols which are crystalline, partly crystalline or vitreously amorphous. And to the extent the compound contains polyether-polyol, the claim further defines such compounds as being selected from the group consisting of polytetramethylene glycols, polypropylene glycols, copolymers of ethylene oxide and propylene oxide, and alkylene diols. Thus, the claim language does not provide an argument that an aromatic diol component is within the reaction product defined by claim 1. For at least these reasons, the instant claims are not anticipated by the 493 patent.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-8, 10-13, and 16-34 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over the 493 patent.

To establish a *prima facie* case of obviousness, there must be some reason, either in the documents of record themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the documents or to combine cited teachings. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Moreover, the cited document (or documents when combined) must teach or suggest all the claim limitations. The reason to make the claimed combination, and a reasonable expectation of success, must be found elsewhere than in Applicants’ disclosure, such as in the cited documents, the nature of the problem to be solved, or in the knowledge/understanding of the person of ordinary skill in the art. MPEP § 2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicants submit that the instant rejection does not meet these requirements. In particular, proper motivation to combine the cited art does not exist.

As discussed above, there is no teaching or suggestion to modify the teaching of the 493 patent to exclude aromatic diols. Thus, the 493 patent does not teach or suggest all the claim limitations. For at least this reason, the 493 patent cannot support a *prima facie* case of obviousness. Withdrawal of the reference is respectfully requested.

Alleged Obviousness-Type Double Patenting

Claims 1-8, 10-13, 16-22, 24, 25, 27-31, and 34 were rejected on the ground of alleged nonstatutory obvious-type double patenting over claims 1-29 of the 493 patent). For reasons analogous to those discussed for the § 103(a) rejection, the nonstatutory obvious-type double patenting rejection should be withdrawn. As discussed above, the whole of the 493 patent does not render the pending claims obvious. As such, a rejection relying on only the claims of the 493 patent also would not render the pending claims obvious.

Conclusion

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejections and an allowance of all of pending claims is earnestly solicited.

Respectfully submitted,

Date: May 13, 2009

/John A. Harrelson, Jr./
John A. Harrelson, Jr., PhD
Registration No. 42,637

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439